

REMARKS

Claims 2-4 and 6-22 are pending in this application, with Claims 1 and 5 cancelled, Claims 2, 4, 6-7, 9-11, and 14 amended, and new Claims 19-22 added. The Applicants respectfully request reconsideration and review of the application as presently amended. By the foregoing amendments, no new matter has been added.

Claims 2, 4, 6-7, 9-11, and 14 have been amended to more clearly distinguish over the prior art, and to more definitively claim the invention. Claims 19-22 have been added, and define embodiments of the invention as described in the specification. The specification has been amended to correct typographical errors.

Before addressing the merits of the rejections based on prior art, a brief description of the present application is provided. The present disclosure describes an invention that, since the filing of the patent application, has been widely adopted by many Internet content providers, and is now familiar to many Internet users. The invention provides a method for interrupting the normal operation of a Web browser to direct a user to additional content provided by a content provider practicing the invention. For example, when a user attempts to exit a first Web page provided by the content provider by using the Web browser's "Back," "Forward," or "Home" button, instead of accessing the second, user-selected Web page that would normally be accessed thereby, the user is instead (or additionally) provided with a third Web page provided by the content provider. In this way, a content provider may extend its access to a user's attention span, regardless of the non-provider Web page the user may select. The widespread and rapid adoption of the invention bears witness to its commercial value and utility. It should be emphasized that, although the invention is now familiar to many, no similar method was known or available to Internet content providers prior to the invention by the Applicant hereof.

The Examiner rejected Claims 1-18 under 35 U.S.C. § 103(a) as unpatentable over Murray. These rejections are respectfully traversed with respect to Claims 2-18. Additionally, with respect to Claims 2, 6, and 10, the Examiner took official notice that

certain elements of the claims are well known, with respect to which the Applicant requests a reference as explained in more detail below.

Murray discloses a method and system for integrating a message, such as an advertising message into specific web content. An exemplary portion of the method disclosed by Murray is summarized in Figs. 4a and 4b, and the following excerpt from column 7, lines 4-49:

A client session begins when a user selects a desired web page by designating a corresponding server's URL address, at step 50 . . . The browser, in response to the command [designating the URL] then directs a request, at step 52, to the corresponding server residing at the selected address. The object manager 30 (Fig. 4a) monitors or listens to all server requests at step 54. The object manager then queries the message server, content server, or local internal file, at step 55, to determine whether a message has been designated for integration with the content that has been requested. If a message has been designated for integration with the content . . . [steps for retrieving, scaling and sizing the message are performed, and] . . . the message is then inserted by the object manager, at step 66, into the reply packets containing the content. The reply packets are then transmitted, at step 68, by the object transport 34 and downloaded to client 12.

Thus, Murray teaches receiving and analyzing a request for content, using an object manager. If the object manager determines that the requested first information content is designated for insertion of a message, then the object manager inserts the message into reply packets containing the content, which are downloaded to the client. The object manager is implemented in software or hardware (see col. 5, lines 5-8), and is either implemented singularly with a stand-alone server, or as a plurality of object managers resident with a plurality of content servers (see col. 8, lines 10-17, and Figs. 1 and 6, respectively). Thus, in all embodiments disclosed by Murray, the object manager is located remotely from the client, and client requests for content are routed through it.

On the bottom of page 2 and top of page 3 of the Office Action, the Examiner equated the object manager of Murray with the "further software" defined in Claims 2-16. This comparison is incorrect, because the further software and the object manager perform different functions, and reside at different locations in the network architecture. The function and the location of the object manager are discussed above. As defined in
LA2:525976.1

Claim 2, the further software "operates on the recipient computer for accessing the first information content on the recipient computer, the further software comprising at least one function operable at the selection of a user for requesting access to second information content." In other words, the further software performs the function of a web browser for displaying web pages. In fact, in an embodiment of the invention defined in Claim 4, the further software is a browser program. As explained above, the object manager does not operate on the client computer, does not operate as a browser to request access to second information (e.g., by generating URL's for content requested by the user), and therefore does not disclose the "further software" of Claims 2-16.

Similarly, although browsers are known in the art, the use of a program routine (i.e., in the "additional software" of Claims 2-16) to interact with a browser (or similar software) according to the present invention is novel. In comparison, Murray also discloses software (object placer 16) on a client computer for communicating and interacting with the object manager. See col. 4, lines 47-63, and col. 7, lines 38-49. However, the object placer does not disclose or suggest the additional software of the present invention, because it does not "provide access to third information content in response to activation of the at least one function in the further software" that requests access to the second information content, as defined in Claims 2-16. Instead, the object placer provides access to an advertising message, inserted in requested content, in response to a browser request for the content. Murray fails to disclose or suggest any interaction or function involving "second information content," as defined in Claims 2-16.

This is not a mere semantic difference or deficiency, but goes to the core functional deficiency of Murray. That is, the invention disclosed by Murray is incapable of preventing or interrupting a user request for second information content, and thereby directing the user to third information content that is not selected by the user. Murray discloses only accepting a user request for content, and inserting therein a message. According to Murray, a user viewing the content with an inserted message is not prevented from ending the display thereof to view other content of the user's selection,

e.g., "second information content," at any time. That is, the method disclosed by Murray can not control the information received by a client, unless the content requested by a user is designated for insertion of a message. In contrast, the present invention defines a method for controlling information received by a client regardless of whether the requested information is designated for combining with other information.

Thus, the method according to Murray operates differently, and achieves a different result, from the present invention in at least three respects. First, Murray discloses only inserting messages into requested content, and not substituting different information for requested content. Therefore, unlike the present invention, Murray fails to disclose redirecting users away from user-requested content. Second, Murray fails to disclose prolonging a user's attention to defined content, because Murray fails to disclose directing a user to defined content when the first requested content is closed by the user using a browser function. Third, because of the vast amount of information content available in wide area networks such as the Internet, advertising messages can feasibly be designated for insertion in only a very limited subset of the total information content available. Consequently, unlike the present invention, Murray fails to disclose an information-redirecting method that is universally applicable regardless of the content or address of user-requested information.

A further deficiency of Murray is the failure to disclose or suggest transferring the object placer, or any other software, to the client computer with the first information content. Murray teaches away from such a coupled transfer, by teaching that the object reporter in the object placer communicates with the object manager for managing interactive capabilities with particular content. See col. 4, lines 59-64. For this communication to be possible, it is necessary that the object placer be in place and be operational prior to delivery of the content to the server, or else the object reporter could not perform its stated function.

For the reasons explained above, Murray, either alone or in combination with any other prior art, fails to disclose or suggest the invention as defined in Claims 2-18. These rejections should therefore be withdrawn.

With respect to the Examiner's statement on page 3 of the Office Action that "provid[ing] access to third information content in response to second information content is well known," the Applicant requests clarification or a reference. If the Examiner intended to refer to well known associations of different information content, for example, sending a third web page to a user when a user selects a link to the third page that exists on a second web page, then the Examiner's statement is correct. However, it has little or no relevance to the patentability of Claim 2, because Claim 2 defines a method with new and additional elements as explained above. On the other hand, if the Examiner intended to say that controlling a recipient computer to redirect a browser from user-selected second content to provider-selected third content (as defined by Claim 2) was well-known at the time the invention was made, then the Applicant respectfully requests that the Examiner specifically cite a reference disclosing such teachings. With respect to Claims 6 and 10, in paragraph 8, page 4 of the Office Action, the Examiner took official notice of similar language for which the above observations and requests are applicable. Similarly, if the second meaning is intended, the Applicant respectfully requests that the Examiner specifically cite a reference disclosing such teachings.

New Claims 19-22 define embodiments of a method and apparatus according to the invention, as described in the specification. Claims 19-20 are directed to a method performed on a network server according to the invention. Claims 21-22 are directed to a server programmed to perform a method according to the invention. Claims 19-22 are allowable over Murray, and the other prior art, for the reasons explained above. Specifically with respect to Claim 19, the prior art does not disclose or suggest a defined set of pages, further comprising program instructions which, in turn, comprise a step for "recognizing a user-selection event on the recipient computer . . . wherein the user-selection event is for requesting a second page of information which is not one of the defined set of pages." Furthermore, the prior art does not disclose or suggest program instructions further comprising "the step of requesting a third page after said recognizing step of the program instructions, wherein the third page is one of the defined pages."

Serial No. 09/183,605
August 8, 2000
Page 13

Nor does the prior art disclose or suggest the combination of pages, program instructions, and server actions as defined in Claim 19. Similar reasoning applies with respect to independent Claim 21. Claims 19-22 are therefore allowable.

In view of the foregoing, the Applicant respectfully submits that Claims 2-4 and 6-22 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited.

Our check in the amount of \$39 is enclosed for the later presentation of one independent claim(s) in excess of three, pursuant to 37 C.F.R. § 1.16(b). While the Applicant believes that no further fees are due, the Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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